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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,608	07/29/2003	Anthony F. Whitemiller		5825

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EXAMINER

PRONE, JASON D

ART UNIT PAPER NUMBER

3724

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,608

Applicant(s)

WHITEMILLER ET AL.

Examiner

Jason Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-16, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 9, 17 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/13/05 & 10/20/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species A in the response filed on 29 July 2005 is acknowledged.
2. No claims have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species. All claims are generic to both species. Election was made **without** traverse in the reply filed on 29 July 2005.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldwitz (4,993,093).

In regards to claim 1, Goldwitz discloses the same invention including a tool having a mount having a path terminating at an opening at one end of the mount (20 and the path is defined by the movement of the blade by 24), a tape measure blade receiving slot being located in said one end of the mount adjacent to the path (30), and a knife blade shuttle selectively movable along the path (24).

In regards to claim 2, Goldwitz discloses the mount includes a surface at said one end extending angularly to relative to the path and having the slot (In Figure 1, the

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side edges of top surface surrounding the slot 30. Also, all things are at an angle relative to each other. 0° is considered an angle).

In regards to claim 4, Goldwitz discloses the slot and the path are oriented relative to one another in a substantially coplanar relationship (Fig. 1 and Fig. 4).

In regards to claim 5, Goldwitz discloses the mount includes first (20) and second housing portions (21) that define the slot in the mount at one part of each of the first and second housing portions (Fig. 2) and the first and second housing portions have means for gripping a tape measure blade received in the slot (31 and 32).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldwitz in view of Black et al. (D386,381). Goldwitz discloses the invention including the surface at said one end is curvilinear (In Figure 1, the side edges of top surface surrounding the slot 30).

However, Goldwitz fails to disclose surface irregularities.

Black et al. teaches surface irregularities (Figs. 6-9). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Goldwitz with surface irregularities, as taught by Black et al., to allow for the user to gain a better grip on a portion of the apparatus requiring the users fingers.

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7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldwitz in view of Huang (US 2002/0124411). Goldwitz discloses the invention including the shuttle includes a blade holding portion (Fig. 4) and a manipulable portion extending away from the blade holding portion and accessible at the mount at a position spaced from the one end (24).

However, Goldwitz fails to disclose a lock-out means in the mount and cooperative with the manipulable portion for prohibiting movement of the shuttle in a preselected circumstance.

Huang teaches a lock-out means in the mount (151) and cooperative with the manipulable portion (322) for prohibiting movement of the shuttle in a preselected circumstance (Page 2, lines 7-9 of paragraph [0023]). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Goldwitz with a lock-out means, as taught by Huang, to prevent the blade from moving to the extended/working position at an unwanted time.

8. Claim 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Deursen et al. (2003/0079294) in view of Goldwitz. In regards to claim 7, Van Deursen et al. discloses the invention including a mount (10) including a handle portion (22) and a head portion (46), a linear path (Fig. 4) formed therein between a terminus in the handle portion (88) and an opening from the head portion (33), a knife blade shuttle selectively movable along the linear path (14), a saw blade (20) pivotally connected at the handle portion (48).

In regards to claim 11, Van Deursen et al. discloses a divider in the mount between the shuttle and the saw blade (136).

However, Van Deursen et al. fail to disclose a tape measure blade receiving slot defined in the head portion and oriented so that the slot and the linear path are substantially coplanar.

Goldwitz teaches a tape measure blade receiving slot defined in the head portion and oriented so that the slot and the linear path are substantially coplanar (30).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Van Deursen et al. with a tape measure blade receiving slot, as taught by Goldwitz, to allow the user to line up the knife at a specific measured distance to perform a cut.

9. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Deursen et al. in view of Goldwitz as applied to claim 7 above, and further in view of Stamper (5,647,129). Van Deursen et al. and Goldwitz disclose the invention including the saw blade is connected in the handle portion at an end opposite the head portion (46 in Van Deursen et al.) and the saw includes a mounting base (20 in Van Deursen et al.) for pivotal connection at the handle portion (46 in Van Deursen et al.).

However, in regards to claim 8, Van Deursen et al. and Goldwitz fail to disclose a cam operatively held in the handle portion and cooperative with the saw blade at one leg and accessible at an opposite leg through the mount at a position spaced from the end of the handle, operation of cam is required from either a stored orientation or a fully extended orientation thereby allowing pivoting movement to the other of the stored or

extended orientation. In regards to claim 10, Van Deursen et al. and Goldwitz fail to disclose the mounting base of the saw blade having first and second detents positioned at locations corresponding the stored and fully extended orientations, and the detents are engageable by one leg of the cam, and a means for biasing the one leg of the cam towards engagement with the detents.

In regards to claim 8, Stamper teaches a cam operatively held in the handle portion and cooperative with the saw blade (318) at one leg (316) and accessible at an opposite leg through the mount at a position spaced from the end of the handle (319), operation of cam is required from either a stored orientation or a fully extended orientation thereby allowing pivoting movement to the other of the stored or extended orientation (312 and 314). In regards to claim 10, Stamper teaches the mounting base of the saw blade having first and second detents positioned at locations corresponding the stored and fully extended orientations (312 and 314), and the detents are engageable by one leg of the cam (Fig. 8), and a means for biasing the one leg of the cam towards engagement with the detents (324). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Van Deursen et al. in view of Goldwitz with a cam and corresponding blade detents, as taught by Stamper, to prevent the knife from opening/closing at an unwanted time.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Deursen et al. in view of Goldwitz as applied to claims 7 and 11 above, and further in view of Ping (6,513,246). Van Deursen et al. and Goldwitz disclose the invention but fail to disclose a magnetic strip for holding a replacement blade.

Ping teaches a magnetic strip for holding a replacement blade (15). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Van Deursen et al. in view of Goldwitz with a magnetic strip, as taught by Ping, to provide a more efficient way of holding spare blades.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Deursen et al. in view of Goldwitz as applied to claim 7 above, and further in view of Black et al. Van Deursen et al. and Goldwitz disclose the invention including a surface adjacent the slot (In Figure 1, the top surface surrounding the slot 30 in Goldwitz).

However, Van Deursen et al. and Goldwitz fail to disclose the surface has striations formed therein.

Black et al. teaches a surface that has striations formed therein (Figs. 6-9). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Van Deursen et al. in view of Goldwitz with surface striations, as taught by Black et al., to allow for the user to gain a better grip on a portion of the apparatus requiring the users fingers.

12. Claims 14, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canino (4,890,387) in view of Goldwitz. In regards to claim 14, Canino discloses the invention including first and second housing portions (17 and 19) forming a mount when assembled (Fig. 1), the mount having a path defined by the first and second housing portion (movement path of blade 22) with the path terminating at an opening between the first and second portions (Fig. 1), an exterior surface of the mount characterized by a plurality of rasp teeth for filing (16a), a knife blade shuttle

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selectively movable along the path (38 and 39), a saw blade pivotally connected in an opposite end of the mount (31). In regards to claim 15, Canino discloses at least one of the first and second housing portions include at least one guide way (29), the shuttle includes a guide (27) and the guideway and the guide cooperatively contain movement of the shuttle (Fig. 3). In regards to claim 19, Canino discloses the saw blade is mounted at one of the first and second housing portion at the interior of the mount (32), the saw blade is pivotable from a store orientation to a fully extended orientation (Fig. 1 double sided arrow) through an elongate space between the first and second housing portions (34).

However, Canino fails to disclose a tape measure blade receiving slot defined in the mount by the first and second housing portion and located in the one end of the mount adjacent the path.

Goldwitz teaches a tape measure blade receiving slot defined in the mount by the first and second housing portion and located in the one end of the mount adjacent the path (30). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Canino with a tape measure blade receiving slot, as taught by Goldwitz, to allow the user to line up the knife at a specific measured distance to perform a cut.

13. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canino in view of Goldwitz as applied to claim 14 above, and further in view of Huang. Canino and Goldwitz disclose the invention including the knife blade shuttle includes a blade

holding portion (39 in Canino) and a manually manipulable portion extending away from the blade holding portion (38).

However, Canino and Goldwitz fail to disclose one of the first and second housing portions include a plurality of detents positioned to be adjacent to the path, the manipulable portion having a resilient arm between the blade holding portion and a slide accessible through an access defined by the first and second housing portions, and a dog located between the slide and the arm releasably engageable in the detents.

Huang teaches one of the first and second housing portions include a plurality of detents positioned to be adjacent to the path (151), the manipulable portion having a resilient arm (32) between the blade holding portion (34) and a slide (321) accessible through an access defined by the first and second housing portions (15), and a dog located between the slide and the arm releasably engageable in the detents (322). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Canino in view of Goldwitz with a detents along with a cooperable knife blade shuttle, as taught by Huang, to prevent the blade from moving to the extended/working position at an unwanted time.

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canino in view of Goldwitz as applied to claim 14 above, and further in view of Moyer, Jr. et al. (5,623,737). Canino and Goldwitz disclose the invention including the raps teeth are oriented directionally to carry material away from the opening at the one end of the mount (16a in Canino).

However, Canino and Goldwitz fail to disclose the rasp teeth are formed transversely at one of the housing portions.

Moyer, Jr. et al. teaches rasp teeth that are formed transversely at one of the housing portions (30). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Canino in view of Goldwitz with a rasp teeth on one housing portion, as taught by Huang, allow for a more comfortable grip of the tool.

Allowable Subject Matter

15. Claims 9, 17, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 9 and 17 disclose the cam interacts with the pivoting of the saw and the movement of the knife blade shuttle along the path. Claim 20 discloses resilient clips configured to grip the tape measure blade.

Conclusion

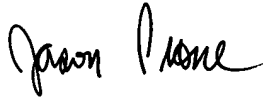
16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mackie, Coffey, Shand, Degabli, Martone et al., Hsu, Van Deursen et al. (2005/0155226), and Cook.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 20, 2005



Patent Examiner
Jason Prone
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T.C. 3700